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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,391	07/17/2003	Anthony J. Bruno	PA0884.ap.US	4665
7590	05/17/2004			
Mark A. Litman & Associates, P.A. York Business Center Suite 205 3209 West 76th St. Edina, MN 55435			EXAMINER LAYNO, BENJAMIN	
			ART UNIT 3712	PAPER NUMBER
DATE MAILED: 05/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/622,391

**Applicant(s)**

BRUNO ET AL.

**Examiner**

Benjamin H. Layno

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 10, 11, 15-21 and 25 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7-9, 12-14, 22-24 and 26-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 051304.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. According to 37 CFR 1.83(a), the drawings must show every feature of the invention specified in the claims. Therefore, drawings are required. In the drawings, the replacement cards, and standard set of cards must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Dahl.

The patent to Dahl discloses a method of playing a wagering game. Dahl's game comprises a standard set of cards. The four Aces and the 4 of clubs are replaced with replacement cards of equal count value. The replacement cards have identifying markings "V", "E", "G", "A", "S", see Fig. 2, that differentiate replacement cards from the standard four Aces and 4 of clubs cards. To play Dahl's game each player places a

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wager, ante, on the underlying card game, poker, and optionally places a wager, side wager, on an auxiliary card game, col. 2, lines 53-55. The dealer deals a first number of cards, three, to the player, and deals a second number of cards, three, to the dealer, col. 2, lines 56-57. A total of five cards are dealt to the player and the dealer as needed to complete the poker game, and all the cards are displayed, col. 3, lines 3-8. If the player's hand has the replacement cards "V", "E", "G", "A", "S", which is at least one replacement card, and the player placed an optional wager, the player is paid \$225,000 for 1. Also if the player has Royal Flush, which inherently has one of the replacement cards, the player is paid \$4000 to 1, see table col. 3, lines 35-44. The player is also paid according to the rules of poker, col. 3, lines 19-22.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl.

The Examiner takes that determining exactly which cards in Dahl's standard 52-card deck to replace with replacement cards having the letters "V", "E", "G", "A", "S", (e.g. the four aces and 4 of clubs; the four 7's and 6 of hearts; the four Kings and Ace of spades, etc.) would have simply been casino business decision for aesthetic

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purposes which is always obvious in the art. Odd of receiving the five "V", "E", "G", "A", "S" cards would still be the same, and it would not change how Dahl's game is played.

6. Claims 10, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ten Stix 21.

The game Ten Stix 21 discloses a method of playing a variant of the Twenty-One game. Ten Stix 21 comprises a plurality of playing cards, six decks of standard 52 playing cards. There is at least one specially marked card, 10 value card with the Ten Stix logo, in each deck. The game is played similar to Twenty-One. During a first time period six decks of cards are used, thus six specially marked cards are provided. The Examiner takes the position that it is well known in the Twenty-One game art to change the number of decks of cards to make cheating, card counting, more difficult. In view of such teaching, it would have been obvious to use eight decks of cards. During a second time period eight decks of cards would have been used, thus eight specially marked cards are provided.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 11, 15, and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 11, the recitation "payout for the presence of at least one specially marked symbol in a hand is different for the payout for the presence of at least one specially marked symbol in a hand" is indefinite.

Claims 18-21 all recite "the replacement cards" which lack antecedent basis. Correction is required.

***Allowable Subject Matter***

9. Claims 11, 15 and 18-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 4, 5, 7-9, 12-14, 22-24 and 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

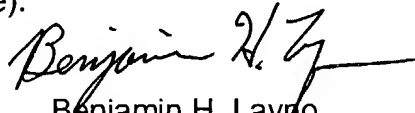
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Boylan et al. discloses a Twenty-One game comprising a deck of cards including no-value cards 20a, 20b added to the deck. A payout is made to a player according to a payable if the player receives no-value cards, see Fig. 2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3712

bhl